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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,900	08/21/2003	Richard Duncan	003797.00620	6418
28319 7590 08/22/2007 BANNER & WITCOFF, LTD. ATTORNEYS FOR CLIENT NOS. 003797 & 013797 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER NGUYEN, MAIKHANH	
			ART UNIT 2176	PAPER NUMBER
			MAIL DATE 08/22/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/644,900

Applicant(s)

DUNCAN ET AL.

Examiner

Maikhanh Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 9, 10, 12-21, 26, 27, 34-37, 42, 43, 45-53, 56 and 58 is/are pending in the application.
- 4a) Of the above claim(s) 18-21, 24, 26, 27, 50-53, 56 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 9-10, 12-17, 34-37, 39, 42-43, and 45-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 08/10/2007.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to the Restriction Requirement filed 07/11/2007.

Claims 1-4, 6, 9-10, 12-17, 34-37, 39, 42-43, and 45-49 are presented for examination.

Claims 7-8 and 40-41 have been canceled. Claims 18-21, 24, 26-27, 50-53, 56, and 58 have been withdrawn from consideration. Claims 1 and 34 are independent claims.

Applicant is required to cancel non-elected claims 18-21, 24, 26-27, 50-53, 56, and 58 in the next response to this Office Action.

### **Election/Restrictions**

2. Applicant's election without traverse of group I (claims 1-4, 6, 9-10, 12-17, 34-37, 39, 42-43, and 45-49) in the reply filed on 07/11/2007 is acknowledged.

### **Request Continuation for Examination**

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

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application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/29/2007 has been entered.

### **Claim Rejections - 35 USC § 101**

4. 35 U.S.C. 101 reads as follows:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

Claim 17 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a signal directly or indirectly by claiming a medium and the Specification (see page 10, ¶ 37) recites evidence where the computer readable medium is define as a “*wave*” (such as a carrier wave). In that event, the claims are directed to a form of energy which at present the office feels does not fall into a category of invention.

### **Rejections - 35 USC § 102**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

Claims 1-4, 6, 9-13, 16-17, 34-39, 42-46, and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by **Altman et al.** (US 2002/0064308, publication date: 05/30/2002).

**As to claims 1 and 34:**

Altman teaches a method, comprising:

- parsing at least a first portion of a base portion of an electronic document (*e.g., standard paragraph parsing ... for paragraphs preceded by bullet characters ... parses each line of text in a document*)[ see ¶¶ 0078-0097];
- creating a first context node associated with the first portion, wherein the first context node includes information identified during the parsing of the first portion (*e.g., automatically identifying bullet characters and creating hanging indents for outlining functions ... by identifying a bullet character ... the distance of the hanging indent for subsequent lines of the same paragraph*) [see ¶¶ 0128 – 0132];
- parsing at least an annotation to the base portion (*e.g., parsing the ink strokes ... determines one by one whether the strokes should be grouped together ... divides*

*the strokes into chained groups, and then associates all the strokes in a chained group with a line) [see ¶¶ 0052-0055, 0059-0061, 0120, and 0129];*

- creating a second context node associated with the annotation to the base portion, wherein the second context node includes information identified during the parsing of the annotation [see ¶¶ 0101, 0103, 0114-0115, 0117, 0120, 0133-0134], wherein the annotation includes electronic ink data (e.g., ink stroke) [see ¶¶ 0047, and 0052], and wherein the first context node and the second context node are arranged in a single hierarchical data structure representing data associated with the electronic document (e.g., the position of the text line, but also the context of the text line in relationship to other text lines ... FIGS. 10A, 10B and 10C are graphical representations of a display area for viewing text) [see ¶¶ 0072-0074, 0085, 0093-0099]; and
- linking the second context node with the first context node (e.g., the association of strokes to lines ... the steps of determining a waterline for a stroke and associating the stroke with the line in which the waterline of the stroke lies ... the strokes are properly clumped in the subsequent processing) [see ¶¶ 0052-0056, 0070, 0085, 0099, 0132 and 0133].

**As to claims 2 and 35:**

Altman teaches the first context node includes a member selected from, among other things, a paragraph node (e.g., a bullet paragraph) [see ¶¶ 0086-0089].

**As to claims 3 and 36:**

Altman teaches the first context node includes a member selected from, among other things, a paragraph node (*e.g., a bullet paragraph*)[see ¶¶ 0086-0089].

**As to claims 4 and 37:**

Altman teaches the second context node is selected from, among other things, a paragraph node (*e.g., a bullet paragraph*)[see ¶¶ 0086-0089].

**As to claims 6 and 39:**

Altman teaches the base portion includes electronic text (*e.g., text in a document*) [see ¶¶ 0085-0096].

**As to claims 9 and 42:**

Altman teaches prior to parsing the annotation, the annotation includes unclassified ink node (*e.g., processing ink stroke representations to identify possible ASCII equivalents ... the user entering an ink stroke with the input device 16 ... to identify the order in which strokes are input into the system ... the system 10 proceeds to step 58 to determine whether any of the strokes entered are global gesture*) [see ¶¶ 0046-0050].

**As to claims 10 and 43:**

Altman teaches rendering the base portion and the annotation (*e.g., retrieving the strokes/words*) [see ¶¶ 0073-0075], wherein the annotation is located at a first position with respect to the base portion [see ¶¶ 0104, 0108, 0111-0112, and 0116-0119]; changing data associated with the base portion such that a location associated with the first context node changes to a second position; and rendering the annotation and the base portion with the changed data, wherein the annotation is rendered at a third position with respect to the base portion at least in part based on the second position of the first context node [see ¶¶ 0046-0048, 0051, 0010, 0104, 0109, and 0121].

**As to claims 12 and 45:**

Altman teaches the first context node and the second context node share at least one common parent node (*e.g., the ink strokes associated with each line are grouped into words ... the words are grouped into paragraphs*) [see ¶¶ 0050 – 0052, 0055, and 0016].

**As to claims 13 and 46:**

Altman teaches data associated with the first context node and the second context node enable the electronic document to be rendered such that the annotation contains the



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first portion of the base document [see ¶¶ 0058, 0060, 0070-0073, 0098-0100, 0107-0108, 0106].

**As to claims 16 and 49:**

Altman teaches data associated with the first context node and the second context node enable the electronic document to be rendered such that a first portion of the annotation points between a second portion of the annotation and the first portion of the base document [see ¶¶ 0053-0055, 0058- 0060, and 0072-0074].

**As to claim 17:**

Altman teaches the use of a computer-readable medium [e.g., memory 18, see fig.1].

### **Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

*This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).*

Claims 14-15 and 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Altman et al.** in view of **Schilit et al.** (US 6687876, filed 12/30/1998).

**As to claims 14 and 47:**

Altman teaches data associated with the first context node and the second context node enable the electronic document to be rendered [see ¶¶ 0058, 0060, 0070-0073, 0098-0100, 0107-0108, 0106].

Altman does not specifically teach the annotation underlines the first portion of the base document.

Schilit teaches the annotation underlines the first portion of the base document (e.g., *underlines*) [col. 7, lines 14-67 and col.9, lines 1 and 8].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Altman with Schilit because it would have provided a unique interface that allows the user to quickly and easily identify any ink stroke representations that are processed by the drawing layer.

**As to claims 15 and 48:**

Altman teaches data associated with the first context node and the second context node enable the electronic document to be rendered [see ¶¶ 0058, 0060, 0070-0073, 0098-0100, 0107-0108, 0106].

Altman does not specifically teach the annotation strikes out the first portion of the base document.

Schilit teaches the use of strikes out the annotation strikes out the first portion of the base document (*e.g., cross-outs*)[col. 7, lines 14- 67 and col.9, lines 1 and 8].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Altman with Schilit because it would have provided a unique interface that allows the user to quickly and easily identify any ink stroke representations that are processed by the drawing layer.

### **Response to Arguments**

7. Applicants' arguments filed 03/29/2007 have been fully considered but are moot in view of the new ground(s) rejection.

### **Conclusion**

8. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

### **Contact information**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**

Commissioner for patents

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